

REMARKS

The Examiner has rejected Claims 41-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,961,758 to Honegger ("Honegger") in view U.S. Patent No. 6,656,103 to Neubauer, et al. ("Neubauer").

The Examiner has also rejected Claims 41, 46, and 47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,363,851 to Gerhard, et al. ("Gerhard") in view of U.S. Patent No. 3,216,719 to Flora ("Flora") and further in view of Neubauer.

The Examiner has also rejected Claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Gerhard, Flora, and Neubauer and further in view of U.S. Patent No. 5,662,448 to Graushar, et al. ("Graushar"). In addition, the Examiner has also rejected Claims 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Gerhard, Flora, Neubauer and U.S. Patent No. 3,816,866 to Miaskoff et al. ("Miaskoff").

Claims 26-40 are currently withdrawn. Claims 1-25 stand previously canceled. Claims 26-50 are currently pending, with claims 44 and 45 being currently amended. Claims 41-50 stand currently rejected. The following remarks are considered by applicant to overcome each of the Examiner's outstanding rejections to current Claims 41-50. An early Notice of Allowance is therefore requested.

I. SUMMARY OF RELEVANT LAW

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The determination of obviousness rests on whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In determining obviousness, four factors should be weighed: (1) the scope and content of the prior art, (2) the differences between the art and the claims at issue, (3) the level of ordinary skill in the art, and (4) whatever objective evidence may be present. Obviousness may not be established using

hindsight or in view of the teachings or suggestions of the inventor. The Examiner carries the burden under 35 U.S.C. § 103 to establish a prima facie case of obviousness and must show that the references relied on teach or suggest all of the limitations of the claims.

II. REJECTION OF CLAIMS 41-46 UNDER 35 U.S.C. § 103(A) OVER HONEGGER AND NEUBAUER

On page 3 of the current Office Action, the Examiner rejects Claims 41-46 under 35 U.S.C. § 103(a) as unpatentable over Honegge and Neubauer. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Claim 41 states, in part:

“a joining device for joining a cover **sheet** to at least one contents **sheet**;

“two guide planes, including a first guide plane and a second guide plane, lying one above the other at a distance from one another and in a parallel orientation to each other, the two guide planes being provided in the vicinity of the folding device, **so that the folding device passes through the guide planes**, for separate placement of the contents **sheet** and cover **sheet** in the first guide plane and the second guide plane, respectively; and

“said folding device being **simultaneously** a joining device so that the sheets can be joined during folding.” (emphasis added).

Applicant respectfully asserts that Honegger in view of Neubauer fails to disclose the above-identified features of Claim 41.

First, the Office Action concedes that Honegger fails to suggest or render predictable a folding device passing through the two guide planes. Instead, the Office Action relies on Neubauer to teach such feature. Applicant submits that Neubauer also fails to disclose, suggest, or render predictable such feature.

Neubauer discloses only one folded sheet 370 is transported by conveyor 390. Only a part, the thick leading portion 380, of the folded sheet is in a guide member 410 with stop member 412. The other part, the thick trailing portion 382, is free. The folding device 416 does

not pass through the guide member 410, but is working beside it. See Figure 13A and Figure 13B of Neubauer. The folding device 416 contacts the sheet in the middle, at the intersection between thick and thin parts 380, 382.

In contrast, claim 41 is directed to a method where the sheets, cover and content, are laying separately in the respective guide plane and the folding knife passes through it.

Applicant submits that a person skilled in the art, having Honegger, would only find advice related to feeding a thicker part of an already folded sheet into a guide member and arranging the folding device beside the guide member.

Accordingly, Applicant respectfully asserts that Examiner has failed to establish a prima facie case of obviousness of independent Claim 41, and corresponding Claims 42-46 because they are dependant from independent Claim 41. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claims 41-43 and 45 under 35 U.S.C. § 103(a) as unpatentable over Honegger in view of Neubauer.

III. REJECTION OF CLAIMS 41, 46, AND 47 UNDER 35 U.S.C. § 102(B) BASED ON GERHARD, FLORA, AND NEUBAUER

On page 4 of the current Office Action, the Examiner rejects Claims 41, 46, and 47 under 35 U.S.C. § 103(a) as being unpatentable over Gerhard, Flora, and Neubauer. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Claim 41 states, in part:

“a joining device for joining a cover sheet to at least one contents sheet;

“two guide planes, including a first guide plane and a second guide plane, lying one above the other at a distance from one another and in a parallel orientation to each other, the two guide planes being provided in the vicinity of the folding device, so that the folding device passes through the guide planes, for separate placement of the contents sheet and cover sheet in the first guide plane and the second guide plane, respectively; and

“said folding device being **simultaneously** a joining device so that the sheets can be joined during folding.” (emphasis added).

In Gerhard, the connection between the sheets is achieved by crimping and saddle stitching and NOT by gluing. Furthermore, the folding step, as shown in Figure 1 under D, is separate and the connecting step, as shown in Figure 1 under F, is separate.

Flora discloses a sheet collator with means to bring groups of sheets in alignment. The stop members are pivotable through an aperture in the table. The connection between the sheets is realized by stitching, not by gluing. The two platforms 64 are not arranged one above the other, but beside each other, even they can have different levels in the high.

Neubauer discloses only one folded sheet 370 is transported by conveyor 390. Only a part, the thick leading portion 380, of the folded sheet is in a guide member 410 with stop member 412. The other part, the think trailing portion 382, is free. The folding device 416 does not pass through the guide member 410, but is working beside it. See Figure 13A and Figure 13B of Neubauer. The folding device 416 contacts the sheet in the middle, at the intersection between thick and thin parts 380, 382.

Applicants submit that Gerhard, Flora, and Neubauer, taken alone or in combination fail to suggest or render predictable, the above-identified features of claim 41.

Accordingly, Applicant respectfully asserts that Examiner has failed to establish a prima facie case of obviousness of independent Claim 41, and corresponding Claims 46 and 47 because they are dependant from independent Claim 41. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claims 41-46 under 35 U.S.C. § 103(a) as unpatentable over Gerhard, Flora, and Neubauer.

IV. REJECTION OF CLAIM 48 UNDER 35 U.S.C. § 103(A) BASED ON GERHARD, FLORA, NEUBAUER AND FURTHER IN VIEW OF GRAUSHAR

On page 6 of the current Office Action, the Examiner rejects Claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Gerhard, Flora, and Neubauer and further in view of

Graushar. This rejection is respectfully traversed and believed overcome in view of the following discussion.

Claim 48 depends from independent Claim 41. As Claim 41 is allowable, so must be Claim 48. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Gerhard, Flora, Neubauer and Graushar.

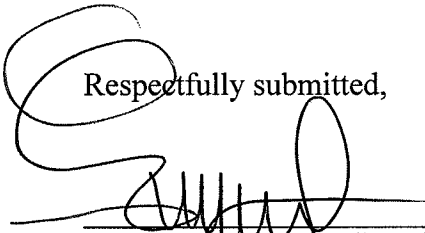
**V. REJECTION OF CLAIMS 49 AND 50 UNDER 35 U.S.C. § 103(A) BASED ON OSAKO IN
VIEW OF MIASKOFF**

On page 7 of the current Office Action, the Examiner rejects Claims 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Gerhard, Flora, and Neubauer and further in view of Miaskoff. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Claims 49 and 50 depend from independent Claim 41. As Claim 41 is allowable, so must be Claims 49 and 50. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claims 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Gerhard, Flora, Neubauer and Miaskoff.

Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,



Eugene LeDonne – Reg. No. 35,930
Joseph W. Ireloar – Reg. No. 60,975
REEDSMITH LLP
599 Lexington Avenue
New York, NY 10022
Tel.: 212.521.5400

EL:JWT
135431.2001